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In re Application of:

Richard Hertzog et al

Serial No. 08/601,879

Filed: February 15, 1996

For: DECOMPOSITION OF CUMENE
HYDROPEROXIDE

DECISION ON PETITION

#57

This is a decision from the PETITION TO THE COMMISSIONER UNDER 37 C.F.R. 1.181, filed March 7, 1997, requesting that the grounds of rejection in the final Office action of August 28, 1996 be withdrawn and the claims 9-14, 16-18 and 20 be treated consistently with and be placed into interference with allowed claims 1, 4, 7-10, 32-34 and 38 in Reexamination Control No. 90/004,314. The petitioner further requests that the finality of the August 14, 1996 Office action be withdrawn as premature under 37 C.F.R. 104(a) and (b) since the instant application and claims were not given a thorough examination, and since a complete explanation of the reasons for rejection of the above claims has not been set forth.

BACKGROUND

1. The instant application was filed February 15, 1996 claiming continuing status, through three earlier continuation applications, to Application Serial No. 07/297,333 filed January 17, 1989.
2. On May 2, 1996 a PRELIMINARY AMENDMENT was filed adding claims 26-28; which was followed by SUPPLEMENT TO PRELIMINARY AMENDMENT on June 13, 1996 and presented additional arguments and a declaration under 37 CFR 1.132 by Mr. Stylianos Sifniades.
3. On July 25, 1996 a REQUEST FOR REEXAMINATION, Control No 90/004,314 was filed requesting reexamination of claims 1-39 of USP 5,254,751 to Zakoshansky.
4. A first (final) Office action in the instant application was mailed August 28, 1996, and contained a rejection of claims 1, 2, 7-28 under 35 U.S.C. 103(a) as being obvious over Sifniades in combination with Anderson et al and Barcilli.
5. On September 23, 1996, an Order Granting/Denying Request for Reexamination was mailed in which reexamination of claims 1-39 of USP 5,254,751 to Zakoshansky was granted.
6. An amendment after-final rejection for the instant application was filed December 30, 1996 in which claim 11 was amended.
7. On January 23, 1997, a Office action was mailed in Reexamination Control No

90/004,314 in which 1-10, 12-20, 22-36, and 38 were allowed and claims 11, 21 37 and 39 were rejected under 35 U.S.C. 103(a).

8. On January 30, 1997 an Advisory action was mailed in the instant application which indicated that the December 30, 1996 after-final amendment to claim 11 would be entered.
9. On March 7, 1997 a supplemental after-final amendment for the instant application was filed in which claims 1, 2, 7, 8, 15, 19, and 21-28 were canceled.
10. On March 12, 1997, a Decision, Sua Sponte, to Merge Reexamination and Reissue Proceedings was mailed in which the proceedings in Reexamination Control No 90/004,314 and reissue Application Serial No. 08/545,092, filed October 19, 1995 were merged. That decision vacated the January 23, 1997 Office action in Reexamination Control No. 90/004,314.

DECISION

After a careful review of the file record it is concluded that the petitioner's request cannot be granted. The Decision vacating of the first Office action of January 23, 1997 in Reexamination Control No. 90/004,314 resulted in the withdrawal of the allowance of claims 1-10, 12-20, 22-36, and 38, as well as the rejection of claims 11, 21, 37 and 39. Therefore, there is currently no basis for the petitioner's request for consistent treatment of claims 9-14, 16-18 and 20 in the instant application with claims 1, 4, 7-10, 32-34 and 38 in Reexamination Control No. 90/004,314 since claims subject to reexamination have not been treated on the merits at this time. The petitioner's request that the instant application be placed into interference also cannot be granted since the instant claims 9-14, 16-18 and 20 do not claim the same or substantially identical subject matter as claims 1, 4, 7-10, 32-34 and 38 in Reexamination Control No. 90/004,314, and since the instant claims have not been allowed. See MPEP 2301.01. Specifically, instant claim 9 states:

“9. An improved method for the decomposition of cumene hydroperoxide by acidic catalyst to phenol and acetone wherein the improvement comprises decomposing cumene hydroperoxide in a non-isothermal manner in the presence of excess acetone in the amount of 10 to 100 percent acetone relative to the amount of acetone produced during the reaction.” (Emphasis added to highlight differences with instant claim 1 below)

while, claim 1 of Reexamination Control No. 90/004,314 (asserted as corresponding to claim 9 in the instant application) states:

“1. An improved method for the decomposition of cumene hydroperoxide by acidic catalyst to phenol and acetone wherein the improvement comprises decomposing cumene hydroperoxide in a non-isothermal manner in the presence of excess acetone whereby the molar ratio of acetone to phenol in a decomposition reactor is from about 1.1:1 to 1.5:1 whereby the rate of decomposition of cumene hydroperoxide is reduced and the reaction is more controllable and more selective.” (Emphasis added to highlight

differences with instant claim 9 above)

Since the applicants admit, at page 4 of the PRELIMINARY AMENDMENT of May 2, 1996, that the claim 9 ratio, 1.1:1 to 2.0:1, of acetone to phenol is broader than the 1.1:1 to 1.5:1 ratio in Claim 1 of Reexamination Control No. 90/004,314, and since the instant claim 9 does not include the additional features of claim 1 in Reexamination Control No. 90/004,314, specifically "the rate of decomposition of cumene hydroperoxide is reduced and the reaction is more controllable and more selective", the instant claim 9 is not viewed as being drawn to the "same or substantially the same subject matter" as claim 1 of Reexamination Control No. 90/004,314. See 35 U.S.C. 135(b) and MPEP 2301.01 at sections (a) and (b). Therefore, the request to place the instant claim 9 (and dependent claims 10-14) into interference with claim 1 (and dependent claims 4, 7-10) of Reexamination Control No. 90/004,314 cannot be granted. Similarly, since claims 16 and 20 of the instant application contain features different from the claims 32 and 38 of Reexamination Control No. 90/004,314, the request to place instant claims 16 (and dependent claims 17 and 18) and 20 into interference with claims 32 (and dependent claims 33 and 34) and 38 of Reexamination Control No. 90/004,314 also cannot be granted. Finally, due to the differences in the ratio of acetone to phenol in the instant application (1.1:1 to 2.0:1) and in the Reexamination Control No. 90/004,314 (1.1:1 to 1.5:1), the examiner has maintained that the instant claims 9-14, 16-18 and 20 are to be rejected under 35 U.S.C. 103(a) over Sifniades in view of Anderson et al and Barcilli. See MPEP 2301.01(c).

The petitioner's request to reconsider and withdraw the rejections under 35 U.S.C. 103(a) in the Office action of August 28, 1996 also cannot be granted since such a matter appealable to the Board of Patent Appeals and Interferences, and is not petitionable. See MPEP 706.01.

With regard to the petitioner's request to withdraw the finality of the August 28, 1996 Office action since said action did not involve a thorough examination of the instant claims or explanation of the rejection, pursuant to 37 CFR 1.104 (a) and (b), a review of the application record reveals that such a request cannot be granted. Initially, it must be pointed out that MPEP Section 706.07(b) states that it is proper to make a first office action final in those situations where:

- "(1) the new application is a continuing application of, or a substitute for, an earlier application, and
- (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly rejected on the grounds or art of record in the next Office action if they had entered in the earlier application."

It is further stated:

"However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was

presented in the earlier application after final rejection or closing of prosecution but was denied entry for one of the following reasons:

- (1) New issues were raised that required further consideration and/or search, or (2) The issue of new matter was raised."

A review of the entire application record including the preliminary amendment of May 2, 1996 and supplemental response of June 13, 1996, as well as the Office action of August 28, 1996, indicates that newly added claims 26-28 were adequately addressed by the rejection in the Office action in question, and said claims would have been properly finally rejected in the previous application if presented therein. It is additionally noted that the same references (Sifniades in combination with Anderson et al, Barcilli) have been used by the examiner in each rejection under 35 U.S.C. 103(a) (spanning four previous continuing applications) since the first office action in Application Serial No. 07/297,333, and the issues regarding of the propriety of such a rejection have been adequately clarified in that record by both the applicants and the examiner. It is further pointed out that the August 28, 1996 Office action adequately addressed the merits of the Sifniades Declaration. Therefore, the finality of the Office action of August 28, 1996 is deemed proper.

The Petition is **DENIED**.


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